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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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KIMBERLY-CLARK WORLDWIDE, INC.
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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,637

Applicant(s)

HARVEY ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This final Office action is responsive to Applicant's amendment filed July 6, 2006.

Claims 1, 2, 4, 6, 7, 9-11, 13-15, 19, 26, 27, 29, and 30 have been amended.

Claims 17 and 18 have been cancelled.

Claims 1-16 and 19-30 are presented for examination.

2. The previously pending objection to the specification is withdrawn in response to Applicant's amendment of the specification.

The previously pending rejections under 35 U.S.C. § 112, 2nd paragraph are withdrawn in response to Applicant's arguments and claim amendments.

In response to Applicant's arguments and claim amendments, the rejection under 35 U.S.C. § 101 asserting lack of usefulness has been withdrawn; however, the issue of lack of tangibility remains (for the reasons addressed in more detail below).

Response to Arguments

3. Applicant's arguments filed July 6, 2006 have been fully considered but they are not persuasive.

Applicant argues, "Page 15 of the Bauer publication does not describe calculating a base preference for the product, calculating downside or calculating an upside as contemplated by the present invention. In fact, the method of the present invention may rely on data collected through a pair comparison test..., but it is not the paired comparison test itself." (Page 13 of Applicant's response) The Examiner

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respectfully disagrees. The "Overall Preference" for the Foaming Spray Head versus the Non-Foaming Spray Head is determined, i.e., calculated, as seen in the table on page 15 of Bauer. This "Overall Preference" reflects a base preference. Based on opinions regarding "Sudsing Preference," "Feels More Slimy," "Easier to Rinse," "Feels Cleaner," and "Removes More Wax From Applies," the preferences for the Foaming Spray Head and Non-Foaming Spray Head, respectively, may be affected positively or negatively (which reflects a downside or upside of each product attribute). Alternatively, the Non-Foaming Spray Head could be set as the base preference of a spray head product, while making the spray head foaming could be an attribute that affects the upside or downside of the product (or vice-versa). Based on either interpretation, Bauer does indeed fully address the limitation in question.

Applicant's argument regarding claims 20 and 21 are based on the aforementioned assertion that Bauer "does not disclose calculating an upside and it does not disclose calculating a downside based on preference results." (Pages 14-15 of Applicant's response) However, the Examiner respectfully disagrees for the reasons presented above.

In conclusion, Applicant's arguments are not persuasive and the art rejection is maintained.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statutory requirement of 35 U.S.C. § 101, a claimed invention must produce a useful, concrete, and tangible result. For a claim to be useful, it must yield a result that is specific, substantial, and credible (MPEP § 2107). A concrete result is one that is substantially repeatable, i.e., it produces substantially the same result over and over again (*In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)). In order to be tangible, a claimed invention must set forth a practical application that generates a real-world result, i.e., the claim must be more than a mere abstraction (*Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77). (Please refer to the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" for further explanation of the statutory requirement of 35 U.S.C. § 101.)

Claims 1-30 revolve around the steps of calculating a base preference for a product, calculating a downside for the product, and calculating an upside for the product. However, these calculations are never applied to produce a real-world result; therefore, the claims do not produce a tangible result. In other words, the calculations may be limited to the mind of a human user or may be calculated by a computer without any conveyance of the results into the real world where the results may have a practical effect. For example, expressly outputting a result of the calculations on a computer screen or physically manufacturing the product with superior attributes would be a tangible result. In conclusion, claims 1-30 are deemed to be non-statutory for failure to produce a tangible result, thereby resulting in a pure abstract idea.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bauer et al. (WO 98/18352 A1).

Bauer discloses a method for determining preference results for a product having an attribute, the method comprising:

[Claim 1] calculating a base preference for the product (Page 15, "Test Design: Paired Comparison" table);

calculating a downside for the product (Page 15, "Test Design: Paired Comparison" table);

calculating an upside for the product (Page 15, "Test Design: Paired Comparison" table); and

comparing the base preference, the downside and the upside to identify product attributes affecting preference results (Page 15 -- The preferences for foaming spray heads versus non-foaming spray heads are compared);

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[Claim 2] wherein the base preference is an overall preference for the product where no test subject prefers the product on its delivery of the attribute (Page 15, "Test Design: Paired Comparison" table – "Overall Preference");

[Claim 3] wherein the base preference is the ratio of the number of test subjects who preferred the product overall but not with respect to the attribute to the number of test subjects who did not prefer the product with respect to the attribute (Page 15, "Test Design: Paired Comparison" table; Page 15, "Surprisingly, consumers were shown to prefer the foaming embodiment of identical cleaning compositions by a greater than 2:1 margin. Interestingly, the foaming article was perceived as performing with less 'Sliminess' and as only fractionally more difficult to rinse off.");

[Claim 4] wherein the downside is an overall preference about the base preference attributable to the attribute (Page 15, "Test Design: Paired Comparison" table; Page 15, "Surprisingly, consumers were shown to prefer the foaming embodiment of identical cleaning compositions by a greater than 2:1 margin. Interestingly, the foaming article was perceived as performing with less 'Sliminess' and as only fractionally more difficult to rinse off.");

[Claim 5] wherein calculating the downside for the product includes taking the difference between a base preference and an overall preference, wherein the overall preference is the ratio of the number of test subjects who preferred the product overall to the total number of test subjects (Page 15, "Test Design: Paired Comparison" table; Page 15, "Surprisingly, consumers were shown to prefer the foaming embodiment of identical cleaning compositions by a greater than 2:1 margin. Interestingly, the foaming

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article was perceived as performing with less 'Sliminess' and as only fractionally more difficult to rinse off.");

[Claim 6] wherein the upside is an overall preference attributable to the maximum potential attribute preference (Page 15, "Test Design: Paired Comparison" table);

[Claim 7] wherein calculating an upside for the product includes taking the difference between an overall preference and a best preference, where the best preference is the ratio of the number of test subjects who preferred the product both overall and with respect to the attribute to the number of test subjects who preferred the product with respect to the attribute (Page 15, "Test Design: Paired Comparison" table; Page 15, "Surprisingly, consumers were shown to prefer the foaming embodiment of identical cleaning compositions by a greater than 2:1 margin. Interestingly, the foaming article was perceived as performing with less 'Sliminess' and as only fractionally more difficult to rinse off.").

[Claims 8-16, 19] Claims 8-16 and 19 recite limitations already addressed by the rejection of claims 1-7 above; therefore, the same rejection applies.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 20-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al. (WO 98/18352 A1).

[Claims 20-30] Claims 20-30 recite limitations already addressed by the rejection of claims 1-7 above; therefore, the same rejection applies.

Furthermore, as per claims 20 and 21, while Bauer teaches the matrix of responses including preference results by input choices (Page 15, "Test Design: Paired Comparison" table), Bauer does not expressly teach that the matrix and corresponding calculation results are generated by a computer and software executed thereon. However, Official Notice is taken that it is old and well-known in the art of automation to utilize software executed by a computer to perform calculations and generate spreadsheets commonly completed by hand. Use of a computer to carry out these functions yields more accurate and rapid generation of calculation and spreadsheet results. Therefore, since Bauer already teaches the recited matrix and calculations, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Bauer to generate the recited matrix and calculations using software executed by a computer in order to yield more accurate and rapid generation of these calculation and spreadsheet (i.e., matrix) results.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Susanna M. Diaz
Primary Examiner
Art Unit 3623

September 18, 2006